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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/079,605  | 02/21/2002  | Thomas Keast         | 435712003521        | 7676             |
| 36544   | 7590        | 01/18/2005           | EXAMINER            |                  |
| BRONCUS TECHNOLOGIES, INC.<br>BUILDING A8<br>1400 N. SHORELINE BLVD.<br>MOUNTAIN VIEW, CA 94043 |             |                      | ROANE, AARON F      |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3739                |                  |

DATE MAILED: 01/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/079,605

Applicant(s)

KEAST ET AL.

Examiner

Aaron Roane

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-31 is/are pending in the application.
- 4a) Of the above claim(s) 7-10, 17 and 22-26 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3-6, 11-16, 18-21 and 27-29 is/are allowed.
- 6) ☒ Claim(s) 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1. ☐ Certified copies of the priority documents have been received.
  - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claims 3-6 (and claims 7-10 if and after they are rejoined) are objected to because of the following informalities:

Claims 3-10 are either directly or indirectly dependent upon claim 2, which has been cancelled. For the purposes of examination, the examiner interprets claims 3-8 as being directly dependent on claim 1.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 31 is rejected under 35 U.S.C. 102(b) as being anticipated by Colley et al. (USPN 4,319,580).

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Regarding claim 31, Colley et al. disclose an ultrasonic/electrical device and method of use, the device comprising an elongate member (54D), a ultrasonic transducer (52) located towards the distal end of the elongate member, an acoustically transmitting material (54) distal to the transducer, and a hollow conductive member (56) located at the distal end of the elongate member and circumferentially disposed about at least a portion of the elongate member, see col. 5-9 and figures 2, 4, 7 and 8. The acoustically matchedness of the transmitting material distal to the ultrasonic transducer is inherent due to the broadest possible interpretation of the term matched.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colley et al. (USPN 4,319,580) in view of Webster, Jr. (USPN 5,916,158).

Regarding claim 30, Colley et al. disclose an ultrasonic/electrical device and method of use, the device comprising an elongate member (54D), a transducer means (74) located

towards the distal end of the elongate member, a energy directing means (52) for directing the source signal and the reflected signal (see specifically the “omnidirectional” ability, which includes front, back and both sides cited in col. 8, lines 31-62), a first conducting member (62A) coupled to the transducer means, a second conducting member (62B) coupled to the transducer means, wherein the first and second conducting members extend from the proximal portion of the elongate member to the distal portion of the elongate member. An energy-conducting means located exterior to the transducer means and the directional means is inherently part of the Colley et al. disclosure, since the device can not function without it, see col. 5-9 and figures 2, 4, 7 and 8. Finally, Colley et al. disclose that the first and second conducting members are connected to a power supply having a “high frequency” power delivery (typically in the MHz range or the RF range), see beginning on col. 1, lines 55 and ending on col. 2, line 7. Colley et al. discloses that the hollow conductive member is an ECG electrode and not an energy conducting means for applying energy to tissue. Webster, Jr. discloses a catheter device with electrodes and teaches the use of a catheter having electrodes capable of performing multiple functions such as ablation, pacing, electrograms, stimulation impedance measurements and mapping, see col. 2, lines 22-44. Webster, Jr. also discloses that the electrodes are coupled to an RF source in order to provide ablation energy or “for applying energy to tissue”, see col. 3, lines 10-18 and col. 9, lines 13-29. This provides the motivation for connecting the hollow conducting member of Colley et al. to an RF energy source in order to provide multiple functions to the electrode including ablation. Therefore, at the time of the invention it would have been obvious to one of ordinary skill

in the art to modify the invention of Colley et al., as is well known in the art and demonstrated by Webster, Jr., to provide the hollow conducting member of Colley et al. with multiple functions in order to perform these multiple functions wherein the electrodes are connected to an RF energy source.

### *Response to Arguments*

Applicant states on page 8 of 9 of the response filed 1/9/2004 that Applicant disagrees with previously made rejection, but has, however, amended the claims in order to expedite prosecution. Additionally, Applicant believes the amendments to claims 30 and 31 overcome the previously made rejections to those claims.

First, the examiner has interpreted claims 3-6 to depend upon claim 1 (instead of claim 2). Secondly, the amendment to claim 30, the recitation of "forward" has done little to overcome the prior art. Omnidirectional means all directions, including forward. Finally, the recitation of "an acoustically matched transmitting material" is easy to meet due to the broad ordinary meaning of the word "matched" or "match". The recitation of "matched", although it can include the meaning disclosed by Applicant on page 7 of the specification, is not restricted to this disclosed meaning by said specification and/or the claim language. Therefore, the examiner is able to interpret and has interpreted the word "matched" in its broadest ordinary meaning.

*Allowable Subject Matter*

Claims 1, 3-6, 11-16, 18-21 and 27-29 are allowed.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on 8am - 7pm, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. *A.R.*  
January 11, 2005

*Roy D. Gibson*  
ROY D. GIBSON  
PRIMARY EXAMINER